

REMARKS

This paper is filed in response to the Office Action mailed on January 13, 2005. In the Office Action, the Patent Office indicates that an IDS citing the patents made of record from parent application Serial No. 10/360,668 is missing. In response, an IDS is submitted herewith.

New claim 30 is a combination of claims 1 and 4 and is therefore allowable along with dependent claims 31-44.

The Patent Office also indicates that the term "improved" is automatically deleted from the title.

The Office Action also objects to the wording of claims 3 and 4 and, in response, these claims have been amended to traverse this rejection. Claim 13 is also objected to and, in response, claim 13 has been amended.

Next, the Office Action rejects claims 1-3, 11-12 and 14-16 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,062,539 ("Kawabe"). In response, claim 1 has been amended to traverse this rejection.

Under MPEP § 2131,

[t]o anticipate a claim, the reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Citing, Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Kawabe does not teach or suggest every element of independent claim 1 as Kawabe does not teach or suggest one adaptor threadably connected to a first rod and a second adaptor threadably connected to a second rod. The Kawabe reference includes no threadable connections between element and therefore cannot serve as an anticipating

reference for independent claim 1 or dependent claims 2-16. Accordingly, Applicants respectfully submit that the anticipation rejection based upon Kawabe has been traversed.

Next, the Office Action rejects claims 1-3, 11-12 and 14-16 under 35 U.S.C. §102(b) as allegedly being anticipated by French Patent No. 2 558 904 ("Bernard"). In response, claim 1 has been amended to traverse this rejection. Specifically, Bernard is merely directed toward a coupling element which includes no threadable connections between any adapter and any rod. Further, the rod union 8 of Bernard does not include a shaped inner cavity as recited in independent claim 1. Therefore, for at least these reasons, the anticipation rejection based upon Bernard has been traversed.

Next, the Office Action rejects claim 13 under 35 U.S.C. §103 as being obvious in view of Kawabe or, in the alternative, in view of Bernard. In response, claim 1 has been amended to traverse both of these rejections. Neither the Kawabe nor the Bernard reference include a threadable connection between any adapter and any rod and therefore neither of these references renders independent claim 1 obvious.

Under MPEP §§ 2142 and 2143,

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Citing, In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *see also* MPEP § 2143-§ 2143.03 for decisions pertinent to each of these criteria.

Kawabe teaches nothing about threadable connection between first and second adapters and first and second rods respectively. Further, Kawabe does not teach or suggest an enclosed shaped internal cavity for receiving the first and second mating elements of the first and second rod adapters. Therefore, Kawabe in no way teaches or suggests every

element of amended independent claim 1 and because Kawabe is directed toward an entirely different type of structure, there is no way in which Kawabe provides any motivation or suggestion as how to modify Kawabe in order to render the connector assembly of amended claim 1 obvious. Accordingly, Applicants respectfully submit that the obviousness rejection of amended dependent claim 13 has been traversed in view of the amendments to independent claim 1.

With respect to Bernard, Bernard in no way teaches or suggests all of the Bernard elements of amended independent claim 1. There is no threadable connection between any rod and any Bernard adapter. Further, the ring 8 of Bernard does not provide the *enclosed* cavity recited in amended independent claim 1. Therefore, Bernard in no way teaches or suggests every claim element of amended independent claim 1 and there is no suggestion or motivation in Bernard that would lead one skilled in the art to arrive at the design of amended independent claim 1. Accordingly, in view of the amendments to independent claim 1, Applicants respectfully submit that the obviousness rejection of claim 13 has been traversed.

With all objections and rejections having been overcome, Applicants respectfully submit that this application is in a condition for allowance and an early action so indicating is respectfully requested.

Dated: January 31, 2005

Respectfully submitted,

By 

Michael R. Hull

Registration No.: 35,902

MARSHALL, GERSTEIN & BORUN LLP

233 S. Wacker Drive, Suite 6300

Sears Tower

Chicago, Illinois 60606-6357

(312) 474-6300

Attorney for Applicant